



GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON VA 20191

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OFFICE OF PETITIONS

In re Patent No. 7,138,128 :
Issued: November 21, 2006 : DECISION ON REQUEST FOR
Application No. 09/436,171 : RECONSIDERATION OF
Filed: November 9, 1999 : PATENT TERM ADJUSTMENT
Attorney Docket No. **BEIERSDORF59** :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(b)" filed October 4, 2006 and "SUPPLEMENTAL APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(d)" filed November 22, 2006. The supplemental application for patent term adjustment under 37 CFR 1.705(d) is properly treated as a separate request for reconsideration of patent term adjustment under 37 CFR 1.705(d).

The application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED**.

The request for reconsideration of patent term adjustment under 37 CFR 1.705(d) is **GRANTED to the extent indicated herein**.

Patentees are given **TWO (2) MONTHS** from the mail date of this decision to respond to this decision. No extensions of time will be granted under § 1.136.

On Application for Patent Term Adjustment under 37 CFR 1.705(b)

On July 26, 2006, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date was five hundred sixty one (561) days. An application for PTA (with required fee), was timely filed October 4, 2006 with payment of the issue fee. Applicants asserted that the patent should have been adjusted by 88 days, not 122 days in association with their response to a non-Final Office Action mailed June 7, 2002. Applicants argue that their response was filed on December 6, 2002, resulting in a delay attributable to applicants of 88 days, and that a courtesy copy of the response was faxed to the Examiner on January 7, 2003. Applicants maintain that no reduction should be entered for the submission of the courtesy copy.

The Office initially determined a patent term adjustment of five hundred sixty one (561) days including one hundred seventy one days of applicant delay. Applicants argue that

the response to the non-Final Office Action mailed June 7, 2002 was filed on December 6, 2002 with a three month extension of time and not on January 7, 2003 as is indicated in PTO records. Applicants further argued therefore that applicant delay should be 88 days.

Applicants' argument has been considered but is not found to be persuasive. A review of the file reveals that the response was received in the office on January 7, 2003 however without any evidence (i.e. certificate of mail, post card receipt or facsimile confirmation) to show that the response was timely filed on December 6, 2002. The image file wrapper is the Official record of the papers received in this application. No response with a date of receipt of (or about) December 6, 2002 is present in the application record. Further, a review of the response received January 7, 2003 does not establish that the response should be considered timely filed on December 6, 2002. The response contained a certificate of facsimile transmission dated December 6, 2002. However, the certificate was not signed. As the certificate is not properly signed and dated, the benefit of 37 CFR 1.8(b) to consider the response timely filed does not apply.

Moreover, for purposes of calculation of the patent term adjustment, the date of receipt of the paper and not the date of any certificate of mailing is used. In this regard, applicant's attention is directed to 37 CFR 1.703(f), which provides that "[t]he date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in this calculation" of patent term adjustment. See also, Comment 10, *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366 (September 18, 2000). As previously indicated, applicants have not shown by submission of a postcard receipt or a facsimile transmission confirmation that the response was received in the Office on December 6, 2002 and thus, that date should be used for purposes of calculating applicant delay pursuant to 37 CFR 1.704(b).

In view thereof, the initial determination of patent term adjustment of 561 days at the time of the mailing of the notice of allowance is correct.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

With respect to the timeliness of the response to the Office action mailed June 7, 2002, applicants are reminded that the application goes abandoned by operation of law for failure to timely prosecute. 35 U.S.C. 133. Accordingly, further action is required by applicants irrespective of the determination of patent term to close this gap in prosecution by establishing of record that the response was timely filed on December 6, 2002, or by filing a petition to revive to close the gap in prosecution.

On Request for Reconsideration of Patent Term Adjustment under 37 CFR 1.705(d)

On November 21, 2006, the above-identified application matured into U.S. Patent No. 7,138,128 with a revised patent term adjustment of five hundred sixty one (561) days. On November 22, 2006, patentees timely submitted the instant request for reconsideration of patent term adjustment, within two months of the patent grant. See § 1.705(d). Patentees contend that a period of reduction of 49 days should not have been entered for a miscellaneous letter filed October 4, 2006. Given their arguments on petition under 37 CFR 1.705(b) and on instant request for reconsideration, patentees maintain that the patent should have issued with a revised patent term adjustment of six hundred forty-four (644) days.

49 days were deducted for applicant delay for a miscellaneous incoming letter filed on October 4, 2006. A review of the application record reveals that the reduction of 49 days was based on the filing after allowance of an Application for Patent Term Adjustment, filed October 4, 2006. 37 CFR 1.704(e) provides that:

The submission of an application for patent term adjustment under § 1.705(b) (with or without request under § 1.705(c) for reinstatement of reduced patent term adjustment) will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraph (c)(10) of this section.

Thus, it is concluded that the patent term adjustment should not have been reduced by 49 days.

In view thereof, the patent should have issued with a revised patent term adjustment of six hundred ten (610) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the request for reconsideration of the revised patent term adjustment under 37 CFR 1.705(d).

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by six hundred ten (610) days.

Telephone inquiries specific to this matter should be directed to Petitions Attorney, Patricia Faison-Ball at (571) 272-3212.

A handwritten signature in black ink, appearing to read "Nancy Johnson". The signature is fluid and cursive, with a large loop at the end of the last name.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosures: Draft Certificate of Correction

DRAFT

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,138,128 B2
DATED : November 21, 2006
INVENTOR(S): Andreas Bleckmann

It is certified that error appears in the above -identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (561) days

Delete the phrase "by 561 days" and insert – by 610 days--